

REMARKS

By this amendment, claims 1-10, and 21-26 are pending, claims 13-16 are withdrawn from consideration, claims 1-10 are currently amended, claims 11, 12, and 17-19 are canceled by the present amendment, claim 20 was previously cancelled, and claims 21-26 are newly presented. No new matter is introduced.

The Office Action mailed January 7, 2010 rejected claims 1-10 under the first paragraph of 35 U.S.C. § 112 as allegedly failing to comply with the enablement requirement, claims 1-10 under 35 U.S.C. § 102(b) as anticipated by *Tatsuta et al.* (US Pub. 2002/0125318) (Tatsuta), and claims 1-10 under 35 U.S.C. § 102(b) as anticipated by Final Fantasy game manual (FF1).

It is noted that claims 1-10 have been amended to add additional structure and remove means plus function language that may have invoked 35 U.S.C. § 112, sixth paragraph.

Claims 1-10 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

This rejection is respectfully traversed. The claims have been amended to remove the terms “data structure” as associating each one of a plurality of device configurations with a respective game configuration that the Examiner asserts lacks enablement.

Further, claim 1 has been clarified to include explicit antecedent basis for “the current device configuration.”

Therefore, it is respectfully requested that the rejections of claims 1-10 under 35 U.S.C. §112 be withdrawn.

Claims 1-10 were rejected under 35 U.S.C. § 102(b) as anticipated by Tatsuta.

In the statement of the rejection the Examiner asserted that Tatsuta identically discloses the claimed features. This rejection is respectfully traversed.

Applicant stresses that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Therasense, Inc. v. Beekton, Dickenson and Company*, 593 F.3d 1289 (Fed. Cir. 2010); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Further, as a matter of procedural due process of law, the Examiner is required to specifically identify where in an applied reference is alleged to disclose each and every feature of a claimed invention, particularly when such is not apparent. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Moreover, there are many fundamental differences between the claimed features and Tatsuta that scotch the factual determination that Tatsuta identically discloses, or even remotely suggests, the claimed inventions.

For example, independent claim 1 recites, *inter alia*, “**associate each one of a plurality of device configurations based, at least in part, on one or more capabilities of a device**, with a respective game configuration, wherein each game configuration differently specifies one or more parameters of the game” (emphasis added). On page 6 of the Office Action, the Examiner argues that paragraphs 105 and 151 of Tatsuta discloses device configurations, which merely states the following:

“The multi-value image information, the binarized image information, the code position/shape information, the **code data and the restored information** are stored in the data RAM 202 of the application program storing cartridge 200 by the CPU 107 by way of the bus bridge 114. Subsequently, any of them is read out by the CPU 302 of the program processing apparatus 300 so that the output data of the restored information, that used to be recorded as code 401 may be provided with randomness.” (Emphasis added) Tatsuta paragraph [0105].

“When the restored information is detected, parameters for the ID, the producer (the person who prepared the code), the type of information, the recording time, the amount of data, etc. can be obtained. Since these parameters vary depending on the information recorded as the code, they can be effectively used as “parameters relating to the recording medium”.’” Tatsuta paragraph [0151].

The Examiner alleges that code data and restored information constitute device configurations for a gaming device. To advance prosecution and reduce issues for potential appeal, claim 1 has been amended to clarify that the “device configurations” are “based, at least in part on one or more capabilities of a device.” Examples of such capabilities include a camera, a flashlight, a vibration maker, etc. as described in paragraph [0035] of the Specification. In contrast, Tatsuta discloses a “code reading apparatus, entertainment system and recording medium” wherein “code reading apparatus main body optically **reads a code from a recording medium**, recording it as optically readable code, and stores the outcome of the reading operation and the parameters acquired during the reading operation in the data RAM of an application **program storing cartridge**.” (Emphasis added). In Tatsuta, paragraph [0105], “multi-value image information, the binarized image information, the code position/shape information, the code data and the restored information” refers to all data read from a recording medium. Such a recording medium can contain code or data (e.g., an image) that can be read and then transferred to the game cartridge or ROM to modify existing game software. Tatsuta paragraph [0174]. Therefore, such a card is used as a medium for transferring additional data to an existing system. An example of such a recording medium is a playing card

on which an image of a monster is printed. Tatsuta, paragraph [0173]. The data stored in such a medium by no means can be considered as “device configuration,” which is “based, at least in part, on one or more capabilities of a device.” In fact, there is no correlation between the real world capabilities of a device and a game in Tatsuta.

The above argued functionally significant differences between the claimed apparatus and those disclosed by Tatsuta undermine the factual determination that Tatsuta discloses a method, apparatus, or computer readable storage medium identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claim 1 and dependent claims 2-10 under U.S.C. §102(b) for anticipation predicated upon Tatsuta is not factually viable and, hence, solicits withdrawal thereof.

Claims 1-10 were rejected under 35 U.S.C. § 102(b) as anticipated by FF1.

In the statement of the rejection the Examiner asserted that Tatsuta identically discloses the claimed features. This rejection is respectfully traversed.

As noted above, that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. There are many fundamental differences between the claimed features and FF1 that scotch the factual determination that FF1 identically discloses, or even remotely suggests, the claimed inventions.

For example, independent claim 1 recites, *inter alia*, “**associate each one of a plurality of device configurations based, at least in part, on one or more capabilities of a device**, with a respective game configuration, wherein each game configuration differently specifies one or more parameters of the game” (emphasis added). On page 11 of the Office Action, the Examiner argues that device configurations include “data pertaining to character, equipment, items, page 11, 15, 35).” As previously noted, claim 1 has been amended to clarify that the “device configurations” are “based, at least in part on one or more capabilities of a device.” It is not understood from pages 11, 15, 35 of FF1 that such a device configuration is based, at least in part, on one or more capabilities of a device. By contrast, all of the mentioned data on pages 11, 15, and 35 of FF1 relate to the tools or the characters provided within the game a game player can use or choose, but it is not understood that these tools or characters are “**based, at least in part, on one or more capabilities of a device.**”

The above argued functionally significant differences between the claimed apparatus and those disclosed by FF1 undermine the factual determination that FF1 discloses a method, apparatus, or computer readable storage medium identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claim 1 and dependent claims 2-10 under U.S.C. §102(b) for anticipation predicated upon FF1 is not factually viable and, hence, solicits withdrawal thereof.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the

undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

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Date

/Phouphanomketh Ditthavong/
Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

Milin N. Patel
Attorney/Agent for Applicant(s)
Reg. No. 62768

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958